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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,060	03/16/2004	Richard G. Middleton	105124-4000	3772
28765	7590	01/19/2006	EXAMINER	
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/802,060

Applicant(s)

MIDDLETON, RICHARD G.

Examiner

Necholus Ogden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

Claims 1-16 and 18-26 are pending.

1. Claims 1-23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton (6,230,353) in view of EP (1300501) or "Carnovale".

***Response to Arguments***

2. Applicant's arguments filed 10-17-2005 have been fully considered but they are not persuasive.

Applicant argues that there is no reasonable expectation of success existing to achieve the method of the presently recited claims.

The examiner contends and respectfully disagrees because Carnovale teaches that the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021). Therefore, in view of the teachings of Carnovale, it appears that the solvent n-propyl bromide (n-PB) would have been commercially successful in the dry-cleaning art absent a showing to the contrary. The examiner further contends that the skilled artisan may not look for economic gains for making a modification; the skilled artisan may look for other gains such as improved environmental factors such as lower toxicity. Furthermore, it has been held "The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. In re Farrenkopf, 713 F.2d 714,219 USPQ 1 (Fed. Cir. 1983). Accordingly, it has been held that "The prior art can be modified or combined to reject claims as prima facie obvious as long as

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there is a reasonable expectation of success". In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that there would not have been any motivation to include the commercially available n-PB of Carnovale because it contains harmful stabilizers.

The examiner contends that the claims are directed toward a broad class of n-PB and they do not distinguish between any specific n-PB. Furthermore, applicant's specification invites the use of stabilizers as dictated by the dry-cleaning method and apparatus (0032).

Applicant argues that there was not suggestion or motivation to combine the teachings of Middleton '353 and Carnovale because one of ordinary skill would not expect the method or apparatus to work or function (i.e. damage the cooling coil or galvanized piping).

The examiner contends that it is not a requirement that the motivation to combine result in a functioning method but that motivation exist to solve a problem such as replacing perchloroethylene with n-PB because the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021). Moreover, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem". It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

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Applicant argues that that motivation would not have existed because one of ordinary skill would not have believed that n-PB could even be used in dry-cleaning applications.

Again, the examiner contends that this would have been an obvious result given that Carnovale specifically teaches advantages of n-PB as a cleaning solvent in dry cleaning apparatuses. "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that the skilled artisan would have checked the MSDS and EPA to determine the suitability of n-PB in dry cleaning.

The examiner contends that the reasons to check the MSDS or EPA are not determining factors of nonobviousness. Carnovale clearly suggest n-PB as a solvent in dry cleaning methods and provides motivation to replace perchloroethylene in the method and apparatus of Middleton. Moreover, it appears that the "concerns" of n-PB may have been outweighed by the toxicity and ground water pollution of perchloroethylene as suggested by Carnovale (0003).

Applicant argues that there would have been no suggestion or motivation to combine the teachings of the '353 patent and Carnovale because of commercially available n-PB were used in the dry-cleaning process of '353 patent, hazardous substances would tend to collect and build up in the distillation equipment of the process.

Again, the examiner contends that reason to modify a reference may be for a different purpose or to solve a different problem that may “The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant”. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Applicant argues that there would have been no motivation to combine the teachings of Middleton '353 and Carnovale to achieve the method of claim 25.

The examiner contends and respectfully disagrees because Middleton '353 specifically teaches the use of a closed loop system comprising at least one pneumatic device (col. 4, lines 40-49) and Carnovale teaches replacing perchloroethylene with n-PB. Therefore, the skilled artisan would have been motivated to combine the reference to produce a dry cleaning method that has a toxicity that is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021).

3. Claims 1,2 5-15, 18-23, 25-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,563,061 in view of EP (1300501).

4. Applicant argues that there is no motivation to combine the reference. However, applicant would like to direct applicant's attention to the arguments above, wherein the examiner maintains the reasons to combine the reference of Middleton '061 like the '353 patent clearly teaches and suggest the method of dry cleaning and EP '501

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provides motivation to replace perchloroethylene with n-PB. Accordingly, the claims are considered obvious and they overlap in subject matter as described in the '061 patent.

5. The 1.132 Declaration under 37 CFR 1.132 filed 10-17-2005 is insufficient to overcome the rejection of claims 1-16, 18-26 based upon Middleton '353 in view of Carnovale as set forth in the last Office action because:

Declarant states in paragraph 8, that the cooling coil would be corroded or damaged by the use of n-mp if the cooling coil is made of galvanized steel, which is the industry standard.

The examiner contends that Declarant's statement that the cooling coil is made of galvanized steel is an assumption that not factual evidence and cannot be given patentably weight.

Declarant states at paragraph 10, that Carnovale did not have a working device such that one of ordinary skill would have looked to Carnovale or commercially available n-PB as a perchloroethylene replacement.

The examiner contends that the operability of Carnovale is not a test for obviousness for the method claims of the present application. As suggested by Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done", reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention combine the

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references is suggested and The court held "it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant," and concluded that here a prima facie case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties." 919 F.2d at 693, 16 USPQ2d at 1901. Therefore, as the motivating force is suggested by Carnovale such as replacing perchloroethylene with n-PB because the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021), one skilled would have combine the references for their intended purpose.

Declarant states at paragraph 10, that there would not be an economically advantage in replacing n-PB for perchloroethylene.

The examiner contends that the skilled artisan may not look for economic gains for making modifications; the skilled artisan may look for other gains such as improved environmental factors such as lower toxicity. Moreover, it has been held "The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. In re Farrenkopf, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983).



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Declarant states in paragraph 11, that the MSDS and EPA provide reasons not to use commercially available n-PB in dry cleaning process because of hazards and expected dangers.

The examiner contends that the reasons to check the MSDS or EPA are not determining factors of nonobviousness. Carnovale clearly suggest n-PB as a solvent in dry cleaning methods and provides motivation to replace perchloroethylene in the method and apparatus of Middleton. Moreover, it appears that the "concerns" of n-PB may have been outweighed by the toxicity and ground water pollution of perchloroethylene as suggested by Carnovale (0003). Again, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant". In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Declarant states in paragraph 12, that there would have also have been no reasonable expectation of success.

The examiner contends and reiterates that the skilled artisan may not look for economic gains for making a combination, however, the skilled artisan may look for other gains such as environmental factors such lower toxicity. Moreover, it has been held that "The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility. In re Farrenkopf,

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713 F.2d 714,219 USPQ 1 (Fed. Cir. 1983). Moreover, Declarant has not provided any cost analysis or financial data supporting this assertion.

Declarant states that in a preferred embodiment the use of commercially available n-PB is not incorporated as a cleaning fluid. Rather, the n-PB that is used consists essentially of n-PB.

The examiner contends that applicant's claim reads on one compound n-propyl bromide and the "consisting essentially of" is construed as "comprising" because applicant has not provided a clear indication that the compound found in Carnovale is excluded. Specifically, the compound found in Carnovale is Comeco 2 and Declarant specifically excludes Techtride. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

### **New Grounds of Rejections**

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aforementioned claims states the phrase "storing at ambient temperature" which does not appear to be present in the instant specification. Applicant is suggested to correct and/or clarify this phrase.

### ***Claim Objections***

8. Claims 1-4,13, 16 and 18 are objected to because of the following informalities: The aforementioned claims state the phrases "first portion" or "initial portion", however, the specification better provides for the terminology of "excess" (0024) which appears to appropriately convey applicant description. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Motsenbocker (6,929,702).

Motsenbocker disclose a composition and method for releasing adherent deposits from surfaces and substrates such as carpet or fabrics (see abstracts).

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Examples I, K and L teach the use of n-propyl bromide as a solvent used in the cleaning composition for removing adherent deposits. (see also claims 1-2).

As this reference teaches all of the instantly required it is considered anticipatory.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP (11-246898).

JP '898 discloses the use of n-PB based solvent composition used in removing stains from fabrics (see abstract).

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-16, 18-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 1-16, 1-14, and 1-20 of U.S. Patent No. 6,009,585 or 6,536,061 or 5,538,646 or 5,916,336, respectively in view of

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EP 1300501. The claims overlap in subject matter pertaining to removing or dry cleaning substances from textiles and separating the fluid from said textiles.

The references fail to suggest applicant's specific solvent n-MP.

EP '501 teaches n-MP as a solvent to replace perchloroethylene in dry cleaning methods.

It would have been obvious to one of ordinary skill in the art to substitute the perchloroethylene of 6,009,585 or 6,536,061 or 5,538,646 or 5,916,336 for the n-MP of EP '501 because EP '501 teaches that replacing perchloroethylene with n-PB because the toxicity is lower than perchloroethylene; no atmospheric risks; no flammability; very high degreasing power; and low evaporation rate (0013-0021).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Necholus Ogden  
Primary Examiner  
Art Unit 1751

No  
1-5-05